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PATRICK MG MIRANDAH

v.

KETUA PENGARAH PERBADANAN HARTA INTELEK MALAYSIA

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HIGH COURT MALAYA, KUALA LUMPUR
RAMLY ALI J
[ORIGINATING SUMMONS NO: D5-21-71-2005]
21 NOVEMBER 2005

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PATENTS: *Registered designs - Inspection of file relating to patent application - Section 34(2) Patents Act 1983 - Whether patent application file may be inspected by members of public*

D

PATENTS: *Registered designs - Whether documents used in relation to patent application are confidential - Whether these documents are classified as official secrets under Official Secrets Act 1972*

On or about 28 September 1994, a patent application was filed at the Malaysian Intellectual Property Office (MyIPO) and
E thereafter was granted on 27 September 2000 ('the said Patent'). On or about 16 June 2005, the plaintiff being a Registered Patent Agent, requested from the defendant certified copies of complete documents in relation to the said Patent including the specification as originally filed, correspondences between the defendant and the
F Patent Agent in charge of the said Patent, amendments and the specification as granted in relation to the said Patent. The plaintiff wanted to inspect the said Patent's file because the plaintiff wanted to advise his client on "non-infringement" on the patent and on "freedom to operate" to ascertain the client's rights to use
G their products, bearing in mind the said Patent. In view of this, the file history of the said Patent's file would be essential to ascertain whether the legal requirements have been met.

The defendant rejected the plaintiff's request on the grounds that
H some of the documents asked for (*ie*, the specification as originally filed, correspondence between the defendant and the Patent Agent for the said Patent application) were confidential documents and should not be given to third parties without the written permission of the said Patent owner. The plaintiff applied for a
I declaration under ss. 33 and 34(1) of the Patents Act 1983 and the Patents Regulations 1986 that the plaintiff be allowed to examine the register and file in relation to the said Patent and to

obtain certified extracts therefrom on payment of the prescribed fee. The defendant contended that the files relating to patent applications (irrespective as to whether patent has been granted or not) are files which are classified as confidential and therefore subject to the Official Secrets Act 1972.

Held (allowing the plaintiff's application):

(1) The Official Secrets Act 1972 was not applicable in this matter because the Act only relates to "official secrets", but not any other information. Therefore, in order to prove that the relevant documents in a patent file is subject to the Official Secrets Act 1972, the defendant must show that those documents were "official secrets" as defined under the Act.

(2) The Official Secrets Act 1972 does not state that documents in relation to a Patent matter is regarded as being "Top Secret", "Secret", "Confidential" or "Restricted". To get the status "official secret", the document must be officially classified (in writing) either by the Minister concerned or any public officer appointed under s. 2B of the Act. The defendant had failed to produce any such classification as required by the Act.

(3) The defendant had not adduced any evidence such as an official notification or directions to prove that the documents in relation to the said Patent application were confidential. The fact that the said Patent had been duly granted showed that the element of confidentiality no longer existed and therefore the plaintiff was clearly entitled to inspect the register and the said Patent's file and to obtain extracts therefrom.

(4) Section 34(2) of the Patents Act 1983 does not prohibit an inspection of a file relating to a patent application if the request for such an inspection is made after the grant of the patent, as in the present case. The prohibition to inspect the file relating to a patent application is only applicable if the request is made before the grant of the patent.

Case(s) referred to:

Cheng Bee Teik & Ors v. Peter Selvaraj & Anor [2005] 2 CLJ 839 CA ***(refd)***

Malaysian Bar v. Dato' Kanagalingam Velupillai [2004] 4 CLJ 194 FC ***(refd)***

Legislation referred to:
Patents Act 1983, ss. 30A(3), 32, 33, 33A(2), 34(1), (2), 83A
Patents Regulations 1986, regs. 29, 30, 31A
Official Secrets Act 1972, ss. 2, 2B, 8

Patents Act 1977 [UK], s. 118(1), (2)
Patents Rules 1995 [UK], r. 93(1), (4), (5)

For the plaintiff - Annabella Subashini; M/s Miranda & Samuel
For the defendant - Rahamantthunnisa Mohd Nizamuddin

Reported by Amutha Suppayah

JUDGMENT

Ramly Ali J:

[1] *Vide* encl. 2, the plaintiff requested for *inter alia*, a declaration under ss. 33 and 34(1) of the Patents Act 1983 and reg. 31A of the Patents Regulations 1986 that the plaintiff be allowed to examine the register and file in relation to Patent No: MY-111611-A granted to The Gillette Company of Prudential Tower Building, Boston, MA 02199, United States of America and to obtain certified extracts therefrom on payment of the prescribed fee.

Facts Of The Case

[2] On or about 28 September 1994, a patent application was filed at the Malaysian Intellectual Property Office (MyIPO) and thereafter was granted on 27 September 2000 *vide* Patent No. MY-111611-A.

[3] On or about 16 June 2005, the plaintiff being a Registered Patent Agent No. PA87/0005 though his firm Patrick Mirandah Co. (M) Sdn. Bhd. had requested from the defendant for certified copies of complete documents in relation to the said Patent Application including but not limited to the specification as originally filed, correspondences between the defendant and the Patent Agent in charge of the said Patent Application, amendments and the specification as granted in relation to the said Patent Application.

[4] The reason why the plaintiff wanted to inspect the said Patent Application file was that the plaintiffs client has instructed the plaintiff to give an advice on "non-infringement" on the patent and a "freedom to operate" advice to ascertain the client's rights to use their products, bearing in mind the said Patent. In view of this, the file history of the said Patent Application file would be essential to ascertain whether the legal requirements have been met.

[5] The defendant *via* the defendant's letter dated 27 June 2005 rejected the plaintiff's request on the grounds that some of the documents asked for (ie, the specification as originally filed, correspondence between the defendant and the Patent Agent for the said Patent application) are confidential documents and shall not be given to third parties without the written permission of the said Patent owner.

[6] The plaintiff now prays to this court for a declaration under s. 33 and 34(1) of the Patents Act 1983 and the Patents Regulations 1986 that the plaintiff be allowed to examine the register and file in relation to the said Patent and to obtain certified extracts therefrom on payment of the prescribed fee.

The Official Secrets Act 972

[7] The defendant contends that the files relating to patent applications (irrespective as to whether patent has been granted or not) are files which are classified as confidential as therefore subject to the Official Secrets Act 1972. To support this contention, the defendant refers to a letter or departmental circular dated 30 September 1995 issued by Bahagian Pengurusan Am, Kementerian Perdagangan Dalam Negeri dan Hal Ehwal Pengguna signed by one Norsham bin Haji Saman on behalf of the Secretary of the said Bahagian Pengurusan Am. The relevant parts of the said circular is reproduced below:

> Tuan/Puan,
>
> **Mempertingkatkan Tahap Keselamatan Jabatan**
>
> Adalah saya dengan segala hormatnya memaklumkan bahawa Pejabat Ketua Pegawai Keselamatan Kerajaan Malaysia telah selesai mengadakan taklimat Pengurusan Rahsia Rasmi di Kementerian ini pada 28hb September 1995.

A 2. Saya berkeyakinan bahawa mereka pada bila-bila masa akan membuat pemeriksaan mengejut di Kementerian ini. Oleh itu adalah diharapkan tuan/puan dapat mempertingkatkan tahap keselamatan Bahagian masing-masing berpandukan perkara berikut:

B (a) Surat Pekeliling Am Sulit 8/7. 1 Tahun 1993

(b) Akta Rahsia Rasmi 1972 (Akta 88)

(c) Surat Pekeliling Am Bil. 2 Tahun 1987

(d) Arahan Keselamatan

C 3. Kerjasama tuan/puan bagi mempertingkatkan tahap keselamatan di Bahagian masing-masing adalah dialu-alukan dan dimestikan.

[8] The court is of the view that the Official Secrets Act 1972 is not applicable in this matter on the following grounds:

D (a) Communication of official secrets to any unauthorised person is prohibited under s. 8 of the Official Secrets Act 1972. It only relates to "official secrets", but not any other information.

E Section 2 of the Official Secrets Act 1972 defines "official secret" as:

> any document specified in the Schedule and any information and material relating thereto and includes any other official document, information and material as my be classified as
F "Top Secret", "Secret", "Confidential" or "Restricted", as the case may be, by a Minister, the Menteri Besar or Chief Minister of a State or such public officer appointed under section 2B.

G (b) The Schedule to the Official Secrets Act 1972 refers to the following documents as being classified as "Top Secret", "Secret", "Confidential" or "Restricted".

> Cabinet documents, records of decisions and deliberations including those of Cabinet committees;

H State Executive Council document, records of decisions and deliberations including those of State Executive Council committees;

> Documents concerning national security, defence and
I international relations.

(c) Therefore, in order to prove that the relevant documents in a patent file is subject to the Official Secrets Act 1972, the defendant must show that those documents are "official secrets" as defined under the Act, either being listed in the Schedule or alternatively being classified as one by a Minister, the Menteri Besar or Chief Minister of a State or such public officer appointed under s. 2B of the same Act.

(d) Clearly the said Schedule of the Official Secrets Act 1972 does not state that documents in relation to a Patent matter is regarded as being "Top Secret", "Secret", "Confidential" or "Restricted".

(e) The only proof the defendant produced is a letter or departmental circular dated 30 September 1995 issued by Bahagian Pengurusan Am, Kementerian Perdagangan Dalam Negeri dan Hal Ehwal Pengguna (as cited above).

(f) The said letter or circular clearly does not amount to a classification of document as 'official secret' under the Act. It is just an administrative direction issued to all heads of departments under the Ministry to "mempertingkatkan tahap keselamatan Bahagian masing-masing" based on the relevant Rules and Regulations, including the Official Secrets Act 1972. To get the status "official secret" the document must be officially classified (in writing) either by the Minister concerned or any public officer appointed under s. 2B of the same Act. The defendant has failed to produce any such classification as required by the Act.

(g) Therefore, the court is satisfied that the Official Secrets Act 1972 is not applicable in the present case.

Laws Relating To Inspection Of Register Of Patents

[9] The laws relating to inspection of Register of Patents is provided under s. 33 of the Patents Act 1983 which reads as follows:

> Any person may examine the Register and may obtain certified extracts therefrom on payment of the prescribed fee.

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Laws Relating To Inspection Of Files

[10] The law relating to inspection of files relating to Patent is provided under s. 34 of the Patents Act 1983 which provides, *inter alia*, as follows:

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(1) Any person may, after the grant of a patent, inspect the file relating to the patent and, subject to subsection (2), the file relating to any patent application, and may obtain certified extracts therefrom on payment of the prescribed fee.

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(2) The file relating to a patent application may be inspected before the grant of the patent only with the written permission of the applicant:

Provided that before the grant of the patent, the Registrar may divulge the following information to any person:

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(a) the name, address and description of the applicant and the name and address of the agent, if any;

(b) the number of the application;

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(c) the filing date of the application and, if priority is claimed, the priority date, the number of the earlier application and the name of the State in which the earlier application was filed or where the earlier application is a regional or an international application, the name of the country or countries for which and the office at which it

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was filed;

(d) the title of the invention;

(e) any change in the ownership of the application and any reference to a licence contract appearing in the file

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relating to the application.

Request For Certified Copies Of Or Extracts From Register Or Files

[11] A request for certified copies of or extracts for the purposes

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of ss. 33, 33A(2), 34 and 83A of the Patents Act 1983 shall be made to the Registrar on Form 5C together with the payment of the prescribed fee. This is provided under reg. 31A of the Patents Regulations 1986.

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Court's Findings

[12] Section 33 of the Act is very clear and unambiguous ie, that any person may examine the Register of Patents kept by the registrar under s. 32 of the Patents Act 1983 and may obtain certified extracts therefrom on payment of the prescribed fee. The application for such an extracts shall be made on Form 5C. Section 34(1), (2) of the Act is also very clear and unambiguous. Section 34(1) refers to a situation "after the grant of a patent" while s. 34(2) refers to a situation "before the grant of the patent." Under s. 34(1), after the grant of a patent, any person may inspect the file relating to the patent and subject to subject to subsection (2) the file relating to any patent application and may obtain certified extracts therefrom on payment of the prescribed fee.

[13] Based on the principles of statutory interpretation, if a statute is clear and unambiguous a literal interpretation would be taken of the words and if there is any ambiguity a purposive approach would need to be taken. This view was taken by the Federal Court in *Malaysian Bar v. Dato' Kanagalingam a/l Velupillai* [2004] 4 CLJ 194, where the court has held that where the words of the statute are plain then it is enough to look at the words. The recent Court of Appeal decision of *Cheng Bee Teik & Ors. v. Peter a/l Selvaraj & Anor* [2005] 2 CLJ 839, has also held that:

> (2) It was a cardinal principle of the interpretation of statutes that the Court should look first to the words of the statute itself, and if these words are plain, it was not permissible to consider what was the intention of the statute or the previous history of the law.

[14] The defendant's letter dated 27 June 2005 rejecting the plaintiff's request cited s. 34(2) of the Act and stated that the documents requested by the plaintiff are confidential and will not be given to any third party without the consent of the applicant or the owner of the Patent. However, in the present case, the Patent in question has been granted on 27 September 2000 and the request was made by the plaintiff on 16 June 2005, clearly after the grant (not before the grant).

[15] In fact reading s. 34(1) of the Act together with s. 34(2) of the Act, it is clear that the legislature intended to differentiate the situation "before the grant" and "after the grant". This is as

s. 34(2) of the Act clearly provided that – "The file relating to patent application may be inspected before grant of patent only with the written permission of the applicant". Therefore, the requirement for the written permission of the applicant is required only if the request is made "before the grant of patent" and therefore, the converse will be true, that is "after the grant", there will be no such requirement of written consent of the applicant.

Issue Of Confidentiality

[16] In their letter dated 27 June 2005, the defendant also stated that the said documents requested by the plaintiff are confidential and will not be given to any third party without the consent of the applicant. However, the fact that the Patent has been duly granted, the element of secrecy and/or confidentiality of the said documents no longer exists.

[17] As to confidentiality the relevant section is s. 30A of the Act, which states as follows:

> (1) Subject to any direction of the Minister, where an application for a patent is filed at the Patent Registration Office and it appears to the Registrar that the application contains information the publication of which might be prejudicial to the interest or security of the nation, he may issue directions prohibiting or restricting the publication of that information or its communication whether generally or to a particular person or class of persons.
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> (2) Subject to any direction by the Minister, the Registrar may revoke any direction issued by him under subsection (1) prohibiting or restricting the publication or communication of any information contained in an application for a patent is he satisfied that such publication or communication is no longer prejudicial to the interest or security of the nation.
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> (3) Where directions issued by the Registrar under subsection (1) are in force in respect of an application, the application may proceed to the stage where it is in order for the grant of a patent but no patent shall be granted in pursuance of such application.

[18] The court is of the view that pursuant to s. 30A(3) of the Act, if the Registrar of Patents is of the view that the documents in relation to the said Patent Application is confidential, then the said patent should not have been granted.

[19] Also, the defendant has not adduced any evidence such as an official notification or directions to prove that the documents in relation to the said Patent application are confidential. The fact that the said Patent has been duly granted shows to prove that the element of confidentiality no longer exists and therefore, pursuant to ss. 33, 34(1) of the Act and reg. 31A of the Patent Regulations 1986, the plaintiff is clearly entitled to inspect the Register and the said Patent Application file and to obtain extracts therefrom.

The File Relating To The Patent Application

[20] Section 34(1) of the Patents Act 1983 talks about "the file relating to patent" as well as "the file relating to any patent application". The file relating to any patent application shall include all documents and correspondence relating to any patent application right from beginning when the application was first made until the grant of the patent ie, the whole application process. It shall also contain all relevant information as listed under regs. 29 and 30 of the Patents Regulations 1986 and all other related documents.

Section 34(2) does not prohibit inspection of file relating to a patent application if the request for such an inspection is made after the grant of the patent, as in the present case. The prohibition to inspect the file relating to a patent application is only applicable if the request is made before the grant of the Patent.

UK's Position – For Comparison

[21] In UK, under the UK Patents Act 1977, s. 118 provides for inspection of documents and r. 93(4) & (5) of the UK Patents Rules 1995 list out expressly the documents which cannot be inspected. Section 118(1) & (2) provides:

> 118 - (1) After publication of an application for a patent in accordance with section 16 above the comptroller shall on a request being made to him in the prescribed manner and on payment of the prescribed fee (if any) given the person making the request such information, and permit him to inspect such documents, relating to the application or to any patent granted in pursuance of the application as may be specified in the request, subject, however, to any prescribed restrictions.

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(2) Subject to the following of this section, until an application for a patent is so published documents or information constituting or relating to the application shall not without the consent of the applicant, be published or communicated to any person by the comptroller.

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[22] Rule 93(1) of the UK Patents Rules 1995 provides:

93 - (1) Subject to paragraph (5) below, and to the restrictions prescribed in paragraph (4) below, after the date of publication of an application for a patent in accordance with section 16, the comptroller shall, upon request and payment of the prescribed fee, if any, permit all documents filed or kept at the Patent Office in relation to the application or any patent granted in pursuance of it, to be prescribed at the Patent Office.

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[23] Rule 93(4) and (5) expressly provides for the restrictions to the right granted under s. 118 and r. 93(1) as follows:

(4) The restrictions referred to in paragraph (1) above are:

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(a) that no document shall be open to inspection until fourteen days after it has been filed at the Patent Office;

(b) that documents prepared in the Patent Office solely for use therein shall not be open to inspection;

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(c) that any document sent to the Patent Office, at its request or otherwise, for inspection and subsequent return to the sender, shall not be open to inspection;

(d) that no document filed at the Patent Office in connection with an application under section 40(1) or (2) or section 41(8) shall be open to inspection unless the comptroller otherwise directs;

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(e) that no request made under rule 48, 49(2) or 92 or this rule shall be open to inspection;

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(f) that documents in respect of which the comptroller issues directions under rule 94 that they are to be treated as confidential shall not be open to inspection, save as permitted in accordance with that rule; and

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(g) that any documents issued by the Patent Office which the comptroller considers should be treated as confidential shall not be open to inspection unless the comptroller otherwise directs.

(5) Nothing in this rule shall be construed as imposing on the comptroller any duty of making available for public inspection:

(a) Any document or any part of a document:

(i) which in his opinion disparages any person in a way likely to damage him; or

(ii) the publication or exploitation of which would in his opinion be generally expected to encourage offensive, immoral or antisocial behaviour; or

(b) The file (but not the report) of the international preliminary examination of an international application under the Patent Cooperation Treaty; or

(c) Any document filed with or sent to or by the Patent Office before 1st Jun 1978.

[24] The position in the UK under UK Patents Act 1977 and the UK Patents Rules 1995 is different from the position in Malaysia under the Malaysian Patents Act 1983 and the Patents Regulations 1986. The provisions in r. 93(4) and (5) of the UK Patents Rules 1995 clearly and expressly provide for restrictions to the right of any person to inspect the file relating patent application. It excludes all information or documents that cannot be supplied for inspection. There is no such similar provisions or restrictions available in our Malaysian Patents Act 1983 nor in the Patens Regulations 1986.

[25] Therefore, under the existing s. 34 of our Patents Act 1983, it is clear that any person may inspect the file relating to a patent, including the file relating to any patent application, after the grant of a patent and may obtain certified extracts therefrom on payment of the prescribed fee. The inspection of the file relating to any patent application being subjected to s. 34(2) of the Act does not pose any restriction to the inspection as the written permission of the applicant only pertains to a situation before the grant of a patent. Since neither the Patents Act 1983 and the Patents Regulation 1986 do not list out the documents which cannot be inspected (as in the UK) the court is of the view that it is the intention of Parliament that any member of the public is entitled to inspect all documents found in the Patent files.

Certified Extracts On Prescribed Fee

[26] Regulations 31A of the Patents Regulations 1986 provides:

> A request for certified copies or extracts for the purposes of sections 33, 33A(2), 34 and 83A of the Act shall be made to the Registrar on Form 5C together with the payment of the prescribed fee.

The prescribed fee for each application is RM50. The applicant must provide all the relevant particulars as required in the said Form 5C, particularly the nature of the request made ie, under which provision of the Act the request is made. The applicant must specify whether the request is made under ss. 33; or 33A(2); or 34; or 83A of the Patents Act 1983. Each application under separate sections must be accompanied with separate prescribed fee.

[27] In the present case, the plaintiff made his request *vide* Form 5C dated 16 June 2005 together with RM50 prescribed fee. In the "REQUEST" column, the plaintiff indicated "The applicant requests the Registrar to issue a certified copy/extract of the matter specified below in accordance with s. 33/3A(2)/34/83A of the Patents Act 1983. MY-111611-A (P1 94002570)."

[28] The court is of the view that the plaintiff's Form 5C is defective, in the sense that the plaintiff had not specified under which particular section the request was made. If the request was only made under one section, then the plaintiff must have deleted the other sections in the "REQUEST" column. If there is no such deletion, it seems that the plaintiff was making the request under all the four (4) relevant sections, as stated therein. If that is the case, then the plaintiff must tender RM200 as prescribed fee for four applications (RM50 for each application). In this case, the plaintiff only tendered RM50 as prescribed fee. Therefore, the defendant is entitled to reject the plaintiff's request for certified copies or extracts of the relevant documents on this ground. The plaintiff is at liberty to make a fresh request conforming to the requirements of Form 5C.

Conclusion

[29] Based on the above considerations the court makes the following declaration:

A declaration under section 33 and 34(1) of the Patents Act 1983 and Regulations 31A of the Patents Regulations 1986 that the Plaintiff be allowed to examine the Register and file in relation to patent application no: MY-111611-A granted to the Gillette Company of Prudential Tower Building, Boston, MA 02199, United States of America and to obtain certified extracts therefrom on payment of the prescribed fee.

[30] Each party to bear their own costs.